



PATENT  
06005/38302B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**RESPONSE TO RESTRICTION REQUIREMENT  
DATED APRIL 22, 2003**

RECEIVED

JUL 28 2003

## GROUP 3

Commissioner for Patents  
Alexandria, Virginia

Sir:

In response to the restriction requirement within the official action dated April 22, 2003, the applicant hereby provisionally elects, *with traverse*, the claims associated with Group I as identified by the examiner, namely claims 1-22, for further prosecution in this application.

## Traverse of the Restriction Requirement

The official action sets forth a restriction requirement between the claims of Groups I and II as related product and process of making the product. The explanation in the official action for the restriction is that the inventions are distinct because the product as claimed can be made by other and materially different processes in accordance with M.P.E.P. §806.05(f). The applicant submits that the restriction requirement is improper and unnecessary for at least the following reasons.

**I. The Restriction Requirement is Improper for Failure to Set Forth a Proper Showing**

The restriction requirement is improper because the official action does not put forth the proper showing, as required in M.P.E.P. §808.02. The action establishes that the inventions in Groups I and II are related and distinctly claimed inventions as defined under M.P.E.P. §806.05(f). If this is the case, then §808.02 requires that, "in order to establish reasons for insisting upon restriction, [the examiner] must show *by appropriate explanation*" (emphasis added) that each of the claim groups requires, in this case, a separate classification. The action has indicated that the two claim groups will be separately classified, but has not provided an *appropriate explanation* as to why they are separately classifiable. The action is improper for at least this reason.

Still further, the explanation provided by the examiner does not provide a *prima facie* reason why the claimed apparatus could be made by a substantially different method, as required under §806.05(f). The examiner indicates that the claimed apparatus can be made by a substantially different method because, according to the examiner, "instead of subjecting the first sealing cartridge to forces resiliently deforming it, the first seal cartridge could be formed with the desired shape prior to insertion into the seal cartridge." (Presumably, the examiner meant to say "prior to insertion of the annular seal member" because claim 23 does not recite inserting the seal cartridge into the seal cartridge but, instead, recites "inserting an annular seal member into the elliptically shaped depression [in the first seal cartridge].") The examiner's logic is faulty, however, for two reasons.

Firstly, the steps of exerting and maintaining forces on the first seal cartridge and later terminating those forces (as recited by claim 23) *is* a process of forming the first seal cartridge with the desired shape (i.e., with an elliptical depression) prior to insertion of the annular seal member. Thus, the examiner's contention that a step of forming the first seal cartridge with the desired shape prior to insertion of the annular seal is materially different than what is recited by claim 23 is incorrect because this is exactly what claim 23 currently recites. The examiner's statement does not, therefore, provide any different method of making the first seal cartridge than that already recited by claim 23, much less a method that is substantially different.

Secondly, if it is the examiner's contention that the first seal cartridge of claim 23 could be made in a different manner than using resilient forces to deform it, forming a circular depression and terminating the resilient forces, the examiner has not suggested any specific manner of doing so. In fact, a contention on the part of the examiner that the first seal cartridge could be formed in a different manner would be pure speculation on the part of the examiner and there is no evidence in the record to support such a contention.

The applicants therefore traverse the restriction requirement on the additional grounds that the official action has failed to set forth or establish reasons by appropriate explanation for insisting upon the restriction, as required under §808.02 and §806.05(f). The restriction requirement should be withdrawn for these reasons and such action is solicited.

## **II. The Standard for Requiring Restriction Has Not Been Met**

Furthermore, the restriction requirement is improper on its face because it does not meet the minimum standard as set forth in M.P.E.P. §803. Section 803 requires two criteria for a proper requirement of restriction between patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Even if it is assumed that the examiner has met this showing, there also "must be a serious burden on the examiner if restriction is required." More specifically, this section clearly states that "if the search or examination of an entire application can be made *without serious burden*, the examiner *must* examine it on the merits, even though it includes claims two independent or distinct inventions" (emphasis added). There is no evidence presented in the official action that search and examination of the entire application would be *any* burden, much less a *serious* burden on the examiner, as is necessary for a proper restriction requirement.

To further support this position, a complete search that is directed to subject matter of the claims from either of Groups I or II will require a search directed to subject matter of the claims from the other group. Because the search and examination of the entire application can be made *without serious burden* on the examiner, it is wasteful of time, effort, and resources for both the applicant and the Patent Office to prosecute the claims in separate applications. Search and examination of all claims together in this application would be much more efficient than requiring both the Patent Office and the applicant to do so separately in multiple applications.

Applicant therefore traverses the restriction requirement on the grounds that the minimum standard for requiring a proper restriction as set for in M.P.E.P. §803 has not been met. The requirement of restriction should be withdrawn and all claims searched and examined in the present application. Such action is respectfully solicited.

### **III. Effect of Improperly Upholding the Restriction Requirement**

The effect of the Patent Office upholding the improper restriction requirement is that the Patent Office admits that the claims of Groups I and II are patentable over the disclosure of any other of these groups. M.P.E.P. §802.01 states that distinctness for a restriction requirement means that two or more subjects as claimed "ARE PATENTABLE" (novel and unobvious) "OVER EACH OTHER" (emphasis in original). The effect of upholding the restriction requirement is that the Patent Office admits that the claims of either Groups I or II are patentable over any disclosure of the claims in the other group.

This position is necessary to entry of the restriction requirement by the Patent Office. Therefore, if the restriction requirement is upheld, the applicant can and will rely upon this position during examination of the application and any continuing applications. If this position is not to be taken by the Patent Office, then the applicant requests that the requirement be withdrawn.

### **IV. Provisional Election**

As required in responding to the restriction requirement, the applicant has provisionally elected to prosecute the apparatus claims 1-22 of Group I. However, as discussed above in the previous sections, the applicant makes this provisional election *with traverse*.

### **Miscellaneous Matters**

Applicant's (and assignee's) attorney has recently taken over prosecution of this case as a result of the assignee purchasing this application from the inventor. The file provided to applicant's attorney appears to indicate that, either, a preliminary amendment was filed at the time of filing of this case canceling claims 1-22 or that the fee associated with the filing of all 32 claims indicated in the April 22, 2003 office action as being present in this case was not paid. The examiner is therefore respectfully requested to carefully review this application to determine which claims are currently present in this application and to assure that the proper

filings fee was paid for all the claims. If the examiner determines that claims 1-22 were originally cancelled, applicant hereby authorizes and requests the examiner to place claims 1-22 of the original application papers back into this application and the Commissioner is hereby authorized to charge any requisite fee therefore (applicant is now a large entity) to Deposit Account No. 13-2855. A copy of this paper is enclosed herewith. Alternatively, the examiner is requested to call the applicant's attorney at the below indicated number to have the applicant take any actions required to place the case in the condition indicated in the office action dated April 22, 2003.

Applicant's attorney also encloses another copy of a New Power of Attorney and Revocation of Prior Powers appointing the undersigned attorney as attorney of record in this case. Please note that the assignment from the inventor to the assignee (a copy of which is also enclosed) is recorded at Reel 013003 Frame 0672. Note also that the Assignee makes the requisite statement under Rule 3.73(b) on the second page of the Power of Attorney and provides a copy of the documentation showing chain of title to the Assignee. Applicant respectfully requests that this Power of Attorney be entered in this case.

Respectfully submitted,

  
Roger A. Heppermann  
Reg. No. 37,641  
MARSHALL, GERSTEIN & BORUN  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6402  
(312) 474-6300

July 22, 2003